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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,798	05/04/2001	Donald L. Siegel	9596-42U3 (053893-5008-02	9049

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EXAMINER	
CELSA, BENNETT M	

ART UNIT	PAPER NUMBER
1639	4

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.	Applicant(s)
09/848,798	Siegel
Examiner	**Art Unit**
Bennett Celsa	1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *one* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *11-14 and 22-37* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *11-14 and 22-37* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 11-14 and 22-37 are currently pending.

NOTE: the location of the present application is **ART UNIT 1639.**

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 11-13 and 22-37, drawn to isolated DNA encoding a protein of seq. Id. 1-69 and 139-181, classified in class 530, subclass 350 (protein) and class 536, subclass 23.1 (DNA).

   II. Claim 14, drawn to an isolated DNA encoding a protein obtainable by screening a DNA library , classified, for example, in class 435, subclass 4+.

2. The inventions are distinct, each from the other because of the following reasons:

3. Groups I and II are independent and/or patentably distinct inventions, since the claims are directed to potentially different and patentably distinct products (e.g. different structure, physicochemical products, use and/or manufacture) since the Group II invention applies to any isolated DNA which encodes proteins outside of the scope of the Group I invention; the Group II invention requires the search and/or examination of method steps not present in the Group I invention; the Group II issues regarding 112/1 and 2nd paragraph and prior art are different; and the classification of groups I and II are different; and due to differences between the Group I and II invention, the bibliographic, structural and classification searches (manual/automated) in patent and literature databases are different and separately burdensome.

4. Because these inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their different classification, subject matter, and are separately and independently searched (e.g. different and separately burdensome manual and computer classification, structure and bibliographic searches), restriction for examination purposes as indicated is proper.

Further Restriction/Election (Group I invention)

5. Group I, claims 11-13 and 22-37 are drawn to:

a. individual, independent, and distinct nucleotide sequences (e.g. Id 70-138 and 182-224) which encode

b. individual and distinct protein sequences (e.g. Id 1-69 and 139-181) in alternative form. The amino acid and nucleotide sequences are patentably distinct because they are unrelated sequences, and a further restriction is applied to each nucleotide (a) and protein (b) sequence above.

Accordingly for elected Group I applicant MUST further elect

a. a single nucleotide sequence (ie. 70-138-182-224) and the corresponding

b. encoded protein sequence (ie. 1-69 and 139-181) (See MPEP 803.04).

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37

CFR 1.141 et seq. The examination of more than one sequence would now pose an undue burden on the Office.

In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

6. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claims is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Should applicant traverse on the ground that the proteins (and the process of use) and antibodies are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

8. Due to the complexity of the above restriction/election, telephone practice was not attempted.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined event though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I)

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)
June 18, 2003

BENNETT CELSA
PRIMARY EXAMINER